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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/294,656	04/19/1999	MICHAEL J. CUSSON	ORACLE01.001	6372

7590 06/14/2004
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EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3624

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/294,656

Applicant(s)

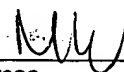
CUSSON ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-35, 53-60, 84-93 and 112-131 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 24-35, 53-60, 84-93 and 112-131 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

1. Claims 24-35, 53-60, 84-93, and 112-131 are pending in response to the communication filed 02/25/04 entered as Response/Reinstatement of Appeal Brief, paper no. 29.
2. The Appeal Brief filed 03/03/03 has been entered as paper no. 23.
3. The Notice of Appeal and Extension of Time filed 05/01/03 has been entered as paper no. 24.
4. Amendment E filed 03/31/03 originally not entered has been entered as paper no. 25.
5. The Defective Brief filed 08/26/03 has been entered as paper no. 26.
6. The Brief filed 10/06/03 has been entered as paper no. 27.
7. As a preliminary matter, Applicants' are respectfully requested to resubmit the IDS filed 05/19/1999 and the "Leverenz et al, Oracle8 Sever Concepts, release 8.0, Oracle Corporation" reference since they are missing from the file.
8. Applicants' finality of the rejection of the last Office action is hereby withdrawn in view of the new ground(s) of rejection here below.

Drawings

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because Figure 1 the reference character "103" has been used to designate both "WEB BROWSER 103" and "CLIENT 103". Figure 2 the reference character "NDR 218" has been used to designate both "NDR 218" and "NDQ 218" and the reference character "NDQ 220" has been used to designate both "NDR 220" and "NDQ 220".

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Element "236" referenced in the Specification as "cache database" and element "237" referenced as "source database server" is missing from the drawing figure 2.

Figure 3 the reference character "HIM" has been used to designate both "HIM 319" and "HIM 311", the reference character "318" has been used to designate both "GQ 318", "GC 318" and "GR 318", the reference character "307" has been used to designate both "QI 307" and "UD 307", and the reference character "LC" has been used to designate both "LC 320" and "LC 316".

Figure 4 the reference character "TRIGGER DEFS 419" has been used to designate both "TRIGGER DEFS 419" and "TRIGGER DEFS 411" and reference character "TRIGGERED MESSAGES TO QUEUE 414" has been used to designate both "TRIGGER MESSAGES TO QUEUE 414" and "MESSAGE QUEUE 414".

Figure 5 has "Field 503" missing from the drawing figure. Is Global Dataset ID. 503" the same as "Field 503" or are they different? Entries "501", CDB DESC. Table 347", and CDB DES. Table 305" is missing from the drawing figure.

The comma after the character is unnecessary. Usually, the character is written as follows: Example, Figure 1: WEB SERVER 107. Figures 2-6 have a similar problem. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

10. The Specification is objected to because Page 4, line 30 reads "... For details, see pages 30-5 through 30-11". This line should read "... For details, see pages 5-30". Figure 2 is referenced as 203 (0...n). The drawing figure labels this as "203(n)". Element "223" is referenced as "cache" and labeled "cached data" in the drawing. Element 203 is referenced as "server 203" and labeled "203(n)" and "203(i)" in the drawing. Element "243" is referenced as "Update transmitter" and in the drawing is labeled as "XMIT 243". Element "251" is referenced as "proper form" and the drawing labels element "251" as "CUDQ". Element "221" is referenced as "Query engine" and the drawing labels "Query Engine" as "239". Element "237" is referenced as "source database server" and labeled in the drawing as "source database 241". **Is element "237" missing or incorrectly labeled?** Element "223" labeled in the drawing figure as "Cached Data 223" and is referenced as "Caches 223" and "cached data 236" in the Specification. **Figures 3-5 have a similar problem.** The Specification and drawing figure characters are not in agreement. The Specification references the character and

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name as one character and the drawing figure has a different character and name for the same part. Applicants' are respectfully requested to review the drawing figures and the specification to place them in agreement with each other. Correction is required.

See MPEP § 608.01(b).

A substitute specification including corrected drawings and the elected claims is required pursuant to 37 CFR 1.125(a) because the specification as addressed above and the drawing character elements are not in agreement with each other.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c)

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 24-35, 53-60, 84-93, and 112-131 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 24-35, 53-60, 84-93, and 112-131 are simply functional limitation claims. A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in

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and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose of that is served by the recited element, ingredient, or step. Whether or not the functional limitation complies with 35 U.S.C. 112, second paragraph is a different issue from whether the limitation is properly supported under 35 U.S.C. 112, first paragraph or distinguished over the prior art. A few examples are set forth below to illustrate situations where the issue of whether a functional limitations complies with 35 U.S.C. 112, second paragraph was considered.

It was held that the limitation used to define a radical on a chemical compound as "incapable of forming a dye with said oxidizing developing agent" although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971). In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions ... being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly, *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). See MPEP 2173.05(g).

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In the instant application, the main issue lies in the fact that the metes and bounds of Applicants' claims cannot be determined by the functional limitations.

Claim 84 in the preamble contains a Transitional Phrase – “in that”. See MPEP 211.03 regarding “Transitional Phrases”.

Election/Restrictions

13. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 24-35, 53-60, and 84-93, drawn to performing queries on remote datasets, classified in class 707, subclass 3.
- II. Claims 112-131, drawn to a distributed database system, classified in class 714, subclass 40.

15. Inventions Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I combination has separate utility such as a query able cache containing copies of certain datasets, an improved server configured to receive a query, making a determination whether a copy of the remote dataset is in the queryable cache, and if the copy is present, performing a query on the copy, and the queryable cache being transparent to the program. Group II the subcombination has separate utility such as a first database system, a redirector responding to the request that includes a specifier that cannot be

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interpreted in the first database system, receiving a request in a first database system, determining whether the request includes a specifier, and when the request includes a specifier, causing the request to be executed in part in a second database system.

16. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

17. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

18. Applicants' are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Inquiries

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


E. Colbert
June 8, 2004